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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHAN CORNELIS TALSTRA,
MAURICE JEROME JUSTIN JEAN-BAPTISTE MAES,
HENDRIK DIRK LODEWIJK HOLLMANN, and
MARTEN ERIK VAN DIJK

Appeal 2008-1455
Application 09/853,174
Technology Center 2100

Decided: November 21, 2008

Before JOSEPH L. DIXON, JEAN R. HOMERE, and
ST. JOHN COURTENAY, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-7 and 10-22. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART and enter a NEW GROUNDS OF REJECTION under 37 CFR § 41.50(b).

THE INVENTION

Appellants' invented a copy protection system. (Spec. 1). An understanding of the invention can be derived from a reading of exemplary claims 1 and 19, which are reproduced below.

1. An apparatus for reading out information from an information carrier, the information including at least a first signal of at least partly encrypted content, comprising:

means for detecting a second signal logically embedded in the first signal wherein the second signal contains a single bit trigger,

means for detecting a physical mark used for storing at least part of the information on the information carrier, and

means for refusing play back of the information read from the information carrier if the second signal but no physical mark has been detected.

19. A method of exchanging copy protection information for protecting information stored on an information carrier including at least a first signal of at least partly encrypted content, wherein:

a physical mark is used for storing at least part of the information on the information carrier, the copy protection information includes a second signal containing a single bit trigger logically embedded in the first signal indicating that a physical mark is used for storing at least part of the information on the information carrier, which copy protection information may be used for refusing play back of the information read from the information carrier if the second signal but no physical mark has been detected.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Glogau	WO 99/11020	Mar. 4, 1999
Taguchi	US 5,915,025	Jun. 22, 1999
Wirtz	US 5,940,134	Aug. 17, 1999

Sedgewick, Robert, *Algorithms*, 2d. ed., Addison-Wesley Publishing Company, Inc., ISBN: 0-201-06673-4, 35-163 (1998).

Bloom, Jeffrey A., *Copy protection for DVD video*, C.B.S. Proceedings of the IEEE ,Vol. 87, No. 7, 1267-1276, (1999).

REJECTIONS

The rejections under 35 U.S.C. § 112 have been withdrawn.

Claims 1-3 and 13-20 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Bloom.

Claims 4-7, 10-12, and 21-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Glogau in view of Bloom and Wirtz. (Note: typographical error in the Examiner's statement of the rejection.)

Rather than reiterate the conflicting viewpoints of the Examiner and Appellants regarding the above-noted rejection, we refer to the Examiner's Answer (mailed May 7, 2007) for the reasoning in support of the rejections, and to Appellants' Brief (filed Jan. 3, 2007) and Reply Brief (filed Jul. 2, 2007) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have carefully considered Appellants' Specification and claims, the applied prior art references, and the respective positions articulated by Appellants and the Examiner. As a consequence of our review, we determine the following.

NEW GROUNDS OF REJECTION

With respect to claims 1-7, 10-11, 14, 15, and 20-22, we enter a new grounds of rejection under 35 U.S.C. § 112, second paragraph since we find that the claims do not particularly point out and distinctly claim the invention.

With respect to claim 20, we enter a new ground of rejection under 35 U.S.C. § 112, second paragraph since claim 20 does not further limit the limitations of independent claim 14. The invention as recited in claim 20 additionally refers to "both apparatuses," but there are three apparatuses set forth (one in the preamble of independent claim 14 and two in the body of claim 20). Also, in claim 20 there is a repetition of a second signal logically embedded in the first signal, but there is a second and first signal recited in independent claim 14 prior to the recitation in claim 20.

With the recitation of a "system" in claim 20 rather than an "apparatus" as in independent claim 14, claim 20 would actually be an independent claim setting forth a different statutory class of invention than independent claim 14, and we find no summary of the claim subject matter for independent claim 20 in the Brief. Here, claim 20 is a type of hybrid claim, and we are unsure of the proper interpretation of the claim limitations.

Cf. IPXL Holdings, L.L.C. v. Amazon.com, Inc., 430 F.3d 1377, 1384 (Fed. Cir. 2005) (A claim directed to a system and a method for using that system is indefinite.). *See also S3 Inc. v. NVIDIA Corp.*, 259 F.3d 1364, 1372 (Fed. Cir. 2001) (“When the claims become so ambiguous that one of ordinary skill in the art cannot determine their scope absent speculation, such claims are invalid for indefiniteness.”) (citing *In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962)).

Next, we note that independent claims 1 and 14 are drafted in "means plus function" limitations. However, we do not find that Appellants' Summary of the Claimed Subject Matter in the Brief provides a useful correlation of the specific "means" to the disclosed structure, acts, or materials to carry out the recited functions. We further note that Appellants' Specification is additionally drafted using "means plus function" descriptors for many of the components in the invention which does not specifically identify a corresponding structure, acts, or materials for these functions at page 8 of the Specification. The "playback apparatus" is further drafted in a high level or functional descriptions or "units" rather than corresponding structure, acts, or materials to perform the functions. Therefore, we are unable to properly interpret the claim limitations under 35 U.S.C. § 112, sixth paragraph.

Considering now the rejections of claims 1-7, 10-12, 14, 15, and 20-22, under 35 U.S.C. §§ 102 and 103, we have carefully considered the subject matter defined by these claims. However, for reasons stated supra in our new rejection under the second paragraph of Section 112 entered under the provisions of 37 C.F.R. 41.50(b), no reasonably definite meaning can be

ascribed to certain language appearing in the claims. As the court in *In re Wilson*, 424 F.2d 1382, 1384 (CCPA 1970) stated:

All words in a claim must be considered in judging the patentability of that claim against the prior art. If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious --the claim becomes indefinite.

In comparing the claimed subject matter with the applied prior art, it is apparent to us that considerable speculations and assumptions are necessary in order to determine what in fact is being claimed. Since a rejection based on prior art cannot be based on speculations and assumptions, *see In re Steele*, 305 F.2d at 862, we are constrained to reverse, pro forma, the Examiner's rejections of claims 1-7, 10-12, 14, 15, and 20-22 under 35 U.S.C. §§ 102 and 103. We hasten to add that this is a procedural reversal rather than one based upon the merits of the section 103 rejections.

35 U.S.C. § 102

With respect to independent claim 13, we find that the pivotal issue is whether Bloom teaches or fairly suggests “refusing playback of the information read from the information carrier if the second signal but no physical mark has been detected.” Appellants argue throughout the Briefs that the prior art of record does not disclose “refusing to playback ...” (App. Br. 12 et seq. and Reply Br. 2 et seq.). The Examiner maintains, that with respect to independent claims 1 and 13, Bloom teaches the claimed limitation with respect to “[o]nly if the additional watermark payload and transformed wobble bits match is playback allowed” at page 10 of the Answer. The Examiner maintains that the use of the phrase “only if ... is playback allowed” is equivalent to Appellants' argued “action that is taken or

prevented from being taken upon the detection of the absence of a wobble groove (physical mark).” We agree with the Examiner’s reasoned conclusion that the recited “only if ...” is equivalent to “refusing” to do a function which is only allowed to be performed in a limited situation. Therefore, if there is no wobble information yet there is a watermark payload present then playback would not be allowed and would be “refused.” Accordingly, we do not find Appellants’ argument persuasive of the error in the Examiner’s initial showing of anticipation of independent claim 13.

With respect to independent claims 16 and 19, we have reviewed Appellants’ arguments set at pages 15-17 of the Brief, and we agree with the Examiner’s initial showing of anticipation, as discussed above with respect to independent claim 13.

With respect to independent claim 17 and dependent claim 18, we note that the claim has internal conflicting limitations. At the beginning of the claim, a physical mark is used for storing information and the end of the claim says that the mark is not detected (implying that there is no mark which was recited to be present initially). With that said, we have reviewed Appellants’ arguments set at pages 16-17 of the Brief, and we agree with the Examiner’s initial showing of anticipation, as discussed above with respect to independent claim 13.

37 C.F.R. § 41.50(b)

37 C.F.R. § 41.50(b) provides that, “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellant, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner ...
- (2) Request rehearing. Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record ...

CONCLUSION

(1) We conclude that Appellants have not established that the Examiner erred in rejecting claims 13 and 16-19 under 35 U.S.C. § 102.

(2) We have pro forma reversed the Examiner’s rejection of claims 1-7, 10-12, 14, 15, and 20-22 under 35 U.S.C. §§ 102 and 103

(3) Since we have entered a new grounds of rejection of claims 1-7, 10-11, 14, 15, and 20-22 under 35 U.S.C. § 112, second paragraph, and our decision is not a final agency action.

(4) Claims 1-7, and 10-20 are not patentable.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-37 C.F.R. § 41.50(b)

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